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EXAMINER

PLUCINSKI, JAMISUE A

ART UNIT

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3629

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/973,082	Applicant(s) BJERRE ET AL.	
	Examiner JAMISUE A. PLUCINSKI	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,8,13-16 and 52-82 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,8,13-16 and 52-82 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/25/09 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-5, 8, 13-16, and 52-67 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. With respect to Claims 1 and 13: the phrase "each of the entities communication with users" is indefinite. The claims are drawn to system claims, which are in essence an apparatus/structure. The term "communicating" is a positive recitation of a method step. Therefore the claim appears to be a hybrid claim, and it is unclear if it is a method claim or a system. The examiner suggests changing "communicating" to "communicates".

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-5, 8, 13-16, 52-58, 60, 61, 63, 65, 68, 69, 71, 73-75 and 77-82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kluss (6,463,419) in view of Carroll et al. (5,293,310).

7. With respect to Claims 1, 13, 14, 68 and 69: Kluss discloses the use of a system for creating booking request pertaining to information relating to the transport of a container (See abstract) comprising:

- a. A plurality of entities registered with the system, each entity having a computer storage (see Figure 1 with corresponding detailed description);
- b. A server (40) at a second entity that is configured to receive information from said computer storage of the plurality of entities over a second communication pathway (See Figures 1 and 15, and Column 4, lines 34-66) and provide a computer user interface for display on a user's computer for inputting information (See Figure 16 with corresponding detailed description); and
- c. The server configured to transmit an electronic booking request to the at least one of the plurality of entities with shipping rates (See Step 1604, Kluss discloses the use of a negotiation, where once the negotiations are sent back and forth between the system, and the ship owner and the charterer (shipper).

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- d. The system configured is to generate electronic event notification messages (Kluss discloses the use of e-mail, which are used for communication, see Figure 12 with corresponding detailed description, and discloses e-mails are sent for communications such as offers and acceptances, therefore the examiner considers this to be an event).
8. Kluss discloses the negotiation of rates is done with the server being the go between the two parties, and fails to disclose the first communication path between the entities/ship owners and the users/charterers/shippers. Carroll discloses the use of a customizable rating schedule, where the rates are negotiated outside of the central server, directly between the carrier (or carrier representative) and the shipper with a first communication pathway between the two (Figure 1, and Column 2, lines 32-38 and Column 5, lines 42-66). This known technique of Carroll of pre-negotiating the rates, as opposed to the negotiating the rate with the central server, is applicable to the Kluss system as they both share characteristics and capabilities, namely they are both directed towards negotiating rates.
9. Since each element is a simply a different way of negotiating rates, one of ordinary skill in the art would have recognized that a simple substitution of one known element/step for another would have produced predictable results rendering the claim obvious. (See KSR [127 S Ct. at 1739] “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”).
10. With respect to Claim 2: Kluss discloses the use of forms which are used for the bookings, the examiner considers the forms to be a form of templates (See Figures 8 and 11 with corresponding detailed descriptions).

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11. With respect to Claims 3 and 4: Kluss discloses the use of templates, however fails to specifically disclose the template is based on a previous booking or previous confirmed booking. However, the specific type of information the template is based on is deemed to be nonfunctional descriptive material and is not functionally involved in the steps recited. A system is limited to the structural limitations and functionalities of the structure, therefore the information a template is based on does not affect the function of the Kluss system. The system using templates for booking requests would function the same way regardless of what type of information the templates are based on. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F .2d 1381, 1385, 217 USPQ 401, 404 (Fed.Cir.1983); *In re Lowry*, 32 F .3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

12. With respect to Claim 5: Kluss discloses that the customer enters basic shipment data as well as detailed shipment data. The type of information that is in the shipment data is considered to be non-functional descriptive data. A system claim is in essence an apparatus claim, and is limited to the structural limitations of the system, therefore due to the fact that what type of information is entered for the shipment data, the system remains unchanged, and functions the same way, therefore Kluss anticipates claim 5.

13. With respect to Claim 8: Kluss discloses a user. However, whether the user is a new customer or an old customer is deemed to be nonfunctional descriptive material and is not functionally involved in the system recited. The system configured to send booking requests would be the same and perform the same functions whether the user is a new customer of the first entity or an old customer. Thus this descriptive material will not distinguish the claimed

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invention from the prior art in terms of patentability, see *In re Gulack*, 703 F .2d 1381, 1385, 217 USPQ 401, 404 (Fed.Cir.1983); *In re Lowry*, 32 F .3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

14. With respect to claims 15-16: See Column 26, lines 41-66.

15. With respect to Claims 52, 53, 73 and 74: See Kluss Figures 6 and 7, the cargo database and the offers database, have loading region and discharge, the examiner considers this to be routing information therefore a routing request.

16. With respect to Claims 54 and 82: Kluss discloses in step 1604 the shipper entering in parameters, the examiner considers this to be shipping parameters.

17. With respect to Claims 55-57: See Figures 4 and 7 with corresponding detailed description.

18. With respect to Claims 58, 60 and 71: See Kluss, Column 6, lines 19-28.

19. With respect to Claims 61, 63 and 65: See Kluss, Column 2, lines 8-13 and Claim 7.

20. With respect to Claim 75: Kluss discloses the user and the carrier entering into a contract, and does not specifically disclose the request comprising a carrier booking number. However, the specific type of information that is contained in the request, such as the carrier booking number, is deemed to be nonfunctional descriptive material and is not functionally involved in the system or the steps recited. The system being capable of sending a booking request would be performed the same regardless of what type of information is on the request. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F .2d 1381, 1385, 217 USPQ 401, 404 (Fed.Cir.1983); *In re Lowry*, 32 F .3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

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21. With respect to Claim 77: Kluss discloses the use of a system that is configured to store and keep track of offers and contracts. The system of Kluss allows a user to modify bids, therefore due to the fact that the claims are directed towards a system, it is the examiner's position that the system of Kluss is fully capable of allowing a user to modify a booking request after a container has been moved.

22. With respect to Claims 78-81: See Klus, Column 9, lines 42-52.

23. Claims 59, 62, 64, 66, 67, 70 and 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kluss and Carroll.

24. As disclosed above for Claims 1 and 68, Kluss discloses the use of electronic communication, but does not disclose expressly that the information is in EDI format, or by the use of a pop-up dialogue box. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have the booking request of Kluss be in the form of an EDI or pop-up dialogue because Applicant has not disclosed the having the communication be either EDI or a pop-up dialogue box, is used for a particular purpose or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with any form of electronic communication because it results in a message (booking request) being sent over a network. Therefore it would have been an obvious matter of design choice to modify Kluss to obtain the invention as specified in Claims 59, 62, 64, 66, 67, 70 and 72.

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25. Claim 76 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kluss and Carroll and in further view of Guidice et al. (6,463,420).

26. With respect to Claim 76: Kluss and Carroll discloses the use of a system that is used in the coordination of shipping. Kluss however, fails to disclose the system being able to track containers. Guidice discloses the use of a system that provides online tracking and delivery stations over the internet (see abstract). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kluss, to include tracking and delivery status capability, as disclosed by Guidice, in order to increase the efficiency and convenience of tracking delivery status, and to provide information to a user. (See Guidice, Column 2)

Response to Arguments

27. Applicant's arguments with respect to claims 1-5, 8, 13-16 and 52-82 have been considered but are moot in view of the new ground(s) of rejection.

28. It should be noted that the examiner has used a reference which was previously applied in rejections of the past. It was argued that the Kluss reference would not be applicable, due to the fact that the booking request was sent to the carrier and shipper via e-mail, not through the server. However after further consideration of Kluss, this is not considered to be true. An email is the way information is sent out, but the e-mail is not directly between the carrier and shipper, the e-mail is sent from the server and saved through the server. Columns 9-12, talk about how the ship owner and the charterer input the information through the server, then an e-mail is sent out to the party (whether it is the charterer or the ship owner) and saved in the e-mail database of the server. Every offer and counter offer is saved through the server (40), and it is entered

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through 40 then an e-mail is sent out. If this was in essence just a bulletin board, and the ship owner and charter e-mail each other outside of the system, and enter into negotiation outside of the system, then none of the e-mails could be saved through the server. For the combination of references, Kluss discloses many steps of offer and counter offers, acceptance and making the contract, and saving and providing the contracts. When combining with Carroll, only one of those steps would be done outside of the server, and that is agreeing on price. The offers and contracts of Kluss could still be done through the server, even though a price is agreed upon outside of the server.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMISUE A. PLUCINSKI whose telephone number is (571)272-6811. The examiner can normally be reached on M-Th (5:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jamisue A. Plucinski/
Primary Examiner, Art Unit 3629